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09/673,790	03/13/2001	Sean Christopher Martin	A33641 PCT/U	4211
21003	7590	09/21/2005	EXAMINER	
BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			HAVAN, THU THAO	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/673,790

**Applicant(s)**

MARTIN ET AL.

**Examiner**

Thu Thao Haven

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**Detailed Action**

***Response to Amendment***

Claims 1-8 are pending. This action is in response to the remarks received June 6, 2005.

***Response to Arguments***

Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because figures 2-4 are incomprehensible. Examiner does not understand the drawings based on the specification. Please clarify. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

***Specification***

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Applicant is reminded of the proper content of an abstract of the disclosure.

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A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

### ***Claim Objections***

Claims 4-8 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim 4 and 6-8. See MPEP § 608.01(n). Accordingly, the claims 4-8 are not been further treated on the merits.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-8, the phrase "such as" or "may be" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ulwick (US 5,963,910) in view of Minder (US 6,144,943).

Re claim 1, Ulwick teaches a technically-implemented decision aid system, which aids a user who is engaged in a selection task, such as a purchasing decision (col., line 25 to col. 2, line 18);

and, which comprises:

- a memory means which stores (fig. 14):

product data, which comprises data relating to a plurality of products and which product data is in the form of a plurality of product-feature-scores ( $S_{i,p}$ ), wherein each individual product-feature-score ( $S_{i,p}$ ) relates to one of a number of predetermined product-

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features (i) for one of the plurality of products (p) and wherein said product-feature-scores ( $S_{i,p}$ ) are values which are constrained to be from predetermined intervals of values ( $S_{min}$  to  $S_{max}$ ) (col. 6, line 42 to col. 7, line 25—weights correspond to score); and

user information, which comprises information relating to preferences of the user and which user information is in the form of a plurality of user-importance-scores ( $I_i$ ) relating to the importance which the user attaches to each of the number of predetermined product-features (i) wherein the user-importance-scores ( $I_i$ ) are values which are constrained to be from a predetermined interval of values which expresses a range of possible levels of importance of a product-feature to the user (col. 15, lines 29-52);

- a user interface which allows the user to interact with the decision aid and which comprises (col. 13, lines 22-41; col. 16, lines 50-67):

- an input device for entering data, such as user-importance-scores ( $I_i$ ), into the decision aid (figs. 3 and 10); and
- a display device for outputting data to the user (col. 19, lines 33-45; figs. 11-12);
- a calculating means which (col. 10, lines 38-57; col. 13, lines 40-59):
  - calculates an overall score ( $S_p$ ) for each of the plurality of products as a function of product-feature-scores ( $S_{i,p}$ ) and user-importance-scores ( $I_i$ ) (col. 19, lines 1-32);
  - and
  - ranks the plurality of products according to the calculated overall scores ( $S_p$ ) to form a ranked list of products (col. 10, lines 38-58; figs. 19-23a);

wherein the display device simultaneously displays (col. 26, lines 16-24; figs. 19a-23a):

- a current set of user-importance-scores ( $I_i$ ) (figs. 10 and 19a-23a); and

- at least a portion of the ranked list of products (figs. 19a-23a);

whereby the technically-implemented decision aid system provides the user with a visual context, which assists the decision-making process by reminding the user of the user-importance-scores ( $I_i$ ) which have been entered whilst simultaneously displaying at least a portion of the ranked list of products (col. 10, lines 38-57; col. 18, line 43 to col. 19, line 60; figs. 19a-23a). *In other words, Ulwick discloses evaluating the potential value of many possible solutions by allowing the user to simultaneously consider all the elements of the complex strategic equation. His invention systematically and intentionally separates the desired outcomes from solutions. This discipline, which is a critical element of a decision making, planning or strategic planning process, is enforced by the invention. At the appropriate time the user is guided to evaluate which desired outcomes would be improved by a specific solution. The magnitude of the improvement can also be recorded. This allows the user to systematically solve a complex simultaneous equation, having many constants and variables, with minimal confusion and ambiguity.*

However, Ulwick does not explicitly teach score. On the other hand, Minder discloses score (col. 4, lines 3-59; figs. 1 and 4). Minder discloses part one score and part two score to generate a grade representative of the quality of services. This grade is then used to make at least one decision regarding the management of services. Thus, it would have been obvious to one of ordinary skill in the art to enable weights corresponding to scores for a system implementing decision aid as discloses in Minder.

Re claim 2, Ulwick teaches product data stored in the memory means further comprises detailed-product-information about each of the plurality of products and in which the display device further simultaneously displays detailed-product-information about one of the products on the displayed portion of the ranked list of products (fig. 19a). *In other words, a product or service as discloses by Ulwick enables customer to rank the products/services.*

Re claim 3, Ulwick teaches product for which detailed-product-information is displayed may be selected by the user using the input device to indicate one of the products on the displayed portion of the ranked list of products for which detailed-product-information should be displayed (figs. 19a-23a). *Figures 19a-23a as discloses by Ulwick display detailed product information.*

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kobayashi et al, US patent no. 6,811,344, teaches computer-aided designing assistant;

Takeyama et al., US patent no. 5,852,560, teaches assessing a load that industrial products apply; and

Herren et al, US 6,108,635, is directed to computer-assisted methodology.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Thao Havan whose telephone number is (571) 272-8111. The examiner can normally be reached on Monday-Friday.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct-uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

TTH  
9/15/2005

VINCENT MILLIN  
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